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REMARKS

The Examiner's time to discuss the instant case by telephone is very much appreciated. Reconsideration and withdrawal of the Examiner's rejections under 35 USC §103(a) is requested in view of the following remarks. Applicants kindly note that the Examiner's rejections of claims 1-11 and 13-29 under 35 USC § 112 have been overcome by the amendments mailed on May 1, 2003.

35 USC § 103

The Examiner has continued the rejection of claims 1 - 11 and 25 - 29 under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322 of record), (US'322) in view of Rigg et al. (US 5,622,692 of record) (US'692) and Stewart (WO/98/30189) for reasons set forth in the prior office action.

The Examiner has continued the rejection of claims 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322 of record), in view of Rigg et al. (US 5,622,692 of record) and Stewart (WO 98/30189), and in further view of Tartaglione (US 4,851,062 of record), for reasons set forth in the prior office action.

Rath et al. relates to a system for combining disparate and separate components to form a customized hair care formulation where the thickener is separate from the product base and is separately added after other enhancing agent ingredients have been added (see, e.g., column 1, lines 33-40, 51-55 and line 65 to column 2, line 1). Rath et al. describes in all cases a low viscosity base which can be selected, a second package containing a compatible thickening composition, and where a wide variety of enhancing additives may be added. Rath et al. teaches away from the present invention where the base composition where appropriate already comprises a thickening agent (see page

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5, lines 21-25). Moreover, amended claim 1 makes clear that the first and second class of performance agents are independently selected from fragrances, colorants, benefit agents, and blends thereof (see instant specification page 2, lines 12-16, 21) and are not thickening agents as separately defined as being part of a base composition (see page 4, line 30 to page 5, line 10) and which must be prepared at a location that is different than where the performance agents are added.

Furthermore, Rath et al. describes that the hair care system which includes a base, a thickener and separate enhancing additives are pre-packaged in the form of a kit (see col. 13, lines 24-27). By specifying multi-part product kits, Rath et al. teaches clearly that each of the component parts of the kit should be pre-selected by a person other than the consumer. The consumer is not intended to be involved in the packaging of the kits disclosed in Rath et al., but only in the possible mixing of the kit components. In contrast, in the present invention, the consumer selects, in any sequence, at least one personal care base composition, at least one variant from the first class of performance agents, and at least one variant from the second class of performance agents. Thus, in the present invention, the component parts of the product are not dictated by a pre-packaged kit selected according to the desire or whim of an unspecified person but by the precise needs of the consumer. The choice of components in the kits of Rath et al. will be limited, and as a result, the consumer may not be able to obtain the precise combination of components which they would like to have (see page 1, lines 22-28 in the instant specification).

The Examiner asserts that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references with respect to applicants' previous arguments. However, it is well settled that the Examiner cannot pick and choose among individual elements of

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assorted prior art references to re-create the claimed invention based on the hindsight of the applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claim combination. See Smith Klein Diagnostics Inc. v. Helena Laboratories Corp., 8 USPQ 2d 1468 (Fed.Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new system, does not necessarily render such a system obvious unless the art also contains something to suggest the desirability of the proposed combination, i.e. the motivation to combine the references. In re Grabiak, 226 USPQ 2d 870, 872 (Fed.Cir. 1985). Consequently, applicants respectfully submit that the rejection under 35 USC 103(a) is improper and should be withdrawn.

The Examiner states that whether a thickener should be a base (common) ingredient or variable is a matter that is within the skill of the artisan which would be obvious depending on the type of products and the population of customers. The Examiner cites the instant specification that states "the viscosity of the product base can be varied from pourable liquid to thick paste or extrudable depending on its composition and the amount of thickener added to the base". Applicants respectfully submit that this definition of the variability of viscosity of the product base has no effect on the definition of performance agents, which are separately defined in the instant specification as described above. Absent impermissible hindsight, the skilled artisan would find no teaching in Rath et al. that a thickener is equivalent to a performance agent. In fact, the instant specification makes clear that the two materials are very different and provides specific examples to elaborate on the differences as discussed above.

The Examiner asserts that there is no clear definition of the "benefit agent" which would exclude a thickener. Applicants respectfully disagree with

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the Examiner. The terms "variants" are used to designate individual performance agents in the instant specification. "Variants as used herein are defined as distinct members of a single class of performance agent which may be selected from such classes as botanical extracts, emollients, vegetable oils, active agents for treating or preventing skin disorders, vitamins, and the like." (See page 2, lines 11-16) fragrances (page 6, line 11) and colorants (page 6, line 29). As stated above, thickeners are separately defined as being a part of the base composition (see page 5, lines 21-25). Since applicants may be their own lexicographer, and the Federal Circuit has held that "when a patent applicant has elected to be a lexicographer by providing an explicit definition in the specification for a claim term, the definition selected by the patent applicant controls". Renishaw PLC v. Marposs Societa'Per Azioni, 48 USPQ 2d 1117 (Fed. Cir. 1998). Applicants therefore respectfully assert that since the definition of performance agent explicitly excludes a thickener, the Examiner cannot read in to performance agents the thickeners of Rath et al. To emphasize the distinction between a base composition and a performance agent or a variant of a performance agent as discussed above, applicants specifically describe a product base that is prepared at a location remote from a second location in which a personal care product based composition is prepared. (See page 2, lines 3-5). Furthermore "the consumer is allowed to select in any sequence one personal care base composition and at least two variants from separate classes of performance agents..." (see page 2, lines 18-21). In this description of applicants' invention, applicants make clear that the components of a base including the thickener (see page 5, lines 22-24) is not the same as a performance agent. This is contrary to the Examiner's assertion that "benefit agents herein include anything useful in the composition, from solvent to preservatives". Applicants specifically define further a base composition as comprising a variety of ingredients including solvents, thickening agents, lathering aids, emollients, pH adjusters, and preservatives (see page 4, line 30 to page 5, line 10). The only type of component that can be classified as both a

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base component and/or a performance agent is an emollient as specifically defined in the instant specification. This means that an emollient can be a component of a base composition (i.e., a base component) and it can also be a variant of a performance agent. No other "base component" is defined as a "performance agent." This is clearly contrary to the Examiner's assertion that "benefit agents herein include anything useful in the composition, from solvent to preservative".

Applicants further note the Examiner's assertion that the color concentrates of Rath et al. have at least five ingredients in common. This feature does not, however, render obvious the claimed method in its entirety since other essential features of the inventive method are not disclosed or suggested by Rath et al. as described above.

Stewart teaches a computer controlled device for evaluating consumer test results and preferences (page 16, lines 10-20). The system includes a base composition and one or more additives that are added to the base (page 22, lines 4-6). Stewart discusses what the principal components of the additives are (page 23, lines 2-6) but is silent about how each additive relates to the other with respect to any ingredients that may be in common with each other. Stewart merely states that additives will typically be dissolved in a solvent, such as water, alcohol, or an oil (page 22, lines 18-19). See also Examples 1-10 on pages 26-32 which discuss all the additional ingredients that can be added to the indicated cosmetic bases but are silent on how the ingredients in each additive relate to each other. Therefore, Stewart does not disclose or suggest the vehicle of each additive have at least two ingredients in common.

Rigg et al. discloses the method and apparatus for customizing facial foundation products. As in Stewart, Rigg et al. discloses a wide range of additives that may be added to a particular formulation (see col. 2, line 61-62).

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As in both Rath et al. and Stewart, there is no disclosure or suggestion regarding how the various additives relate to each other with respect to ingredients in each additive that may be in common with each other. Therefore Rigg et al. does not disclose or suggest the vehicle of each additive have at least two ingredients in common.

Applicants respectfully submit that Tartaglione does not remedy the deficiencies of Rath et al., Rigg et al., and Stewart with respect to the instant claims as amended.

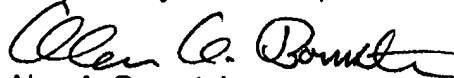
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CONCLUSION

In light of the above remarks, applicants submit that all claims now pending in the present application are in condition for allowance. Reconsideration and allowance of the application is respectfully requested.

If a telephone interview would facilitate prosecution of the application, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,



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